

REMARKS

I. Introduction.

Claims 1-14, 29 and 30 remain pending in the above-identified application, with claims 1-5 and 29 having been hereby amended in response to the Office Action of May 17, 2005. In view of the above amendments and the following remarks, reconsideration and allowance of the application is respectfully requested. No new matter has been added.

II. Objections to the Drawings.

The Examiner has requested new corrected drawings in compliance with 37 C.F.R. 1.121(d) in this application because the drawings filed September 24, 2003 are informal. In addition, the drawings were objected to as failing to comply with 37 C.F.R. 1.84(p)(5) because they do not include the reference numeral 35 that is mentioned in the description. Lastly, the Examiner noted that Figure 21 should be designated by a legend such as "Prior Art" because only that which is old is illustrated.

In response to the Examiner's objections, the Figures 1-21 have been so corrected, and are contained on ten sheets each appropriately marked "Replacement Sheet". With regard to the addition of the reference numeral 35, Figure 9 has been corrected in accordance with the Specification at paragraph 69. No new matter has been added.

Accordingly, all of the Examiner objections to the Drawings having been addressed, the Applicant respectfully requests that such objections be withdrawn.

III. Objections to the Specification.

The Examiner has objected to paragraphs [0066], [0071], [0074], [0077], and [0079] of the Specification of the above-identified patent application as not being understood because they are inconsistent with the drawings. In particular, with respect to paragraph [0066] it is not understood how the embodiment described as the fourth embodiment may be utilized with the ball bearing shown in Figure 18, as there is no separate inner race to be preloaded in Figure 18. In addition, with respect to the remaining enumerated paragraphs, these refer to embodiments being utilized with ball bearings shown in Figures 20 and 21, yet Figure 21 has been noted as being prior art, and neither of these Figures shows the stepped configuration of the sleeve as described in these paragraphs.

In response to the Examiner's objections, the enumerated paragraphs have been amended above to correctly identify the corresponding figures. No new matter has been added.

Accordingly, all of the Examiner objections to the Specification having been addressed, the Applicant respectfully requests that such objections be withdrawn.

IV. Claims Rejections under 35 U.S.C. § 112.

Claim 4 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the Examiner states that claim 4 recites "a second ball race formed directly on an inner surface of said sleeve" and "a second row of bearing balls", which implies a first of each, yet no first ball race or first row of bearing balls is positively set forth in the claim of the claims from which it depends.

In response, claim 4 has been amended to delineate between the "first" and "second" ball race, and to delete reference to a "second" row of bearing balls. Claim 3 has likewise been amended.

Accordingly, Applicant believes that such amendments remedy any deficiency with respect to 35 U.S.C. § 112, second paragraph, and that therefore the claims are now allowable.

V. Claim Rejections under 35 U.S.C. § 102.

The Examiner has made numerous 35 U.S.C. §§ 102 (a) and (b) rejections of the claims of the present application. That is, Claims 29 and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Horberg (U.S. Patent No. 2,953,417); Claims 1, 10, 13, 29 and 30 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Standing et. al. (4,173,376); Claims 1, 2, 8, 11, 12, 14 and 29 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Miyatake et. al. (4,719,352); Claims 1, 8-10, 12 and 29 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Ogata et. al. (5,000,589); Claim 29 and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Ohtsuki et. al. (5, 718, 049); Claims 1, 8, 11, 12, 14 and 29 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Beaman (5, 829, 891); Claims 1-8, 11-13, 29 and 30 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Bhatt (5,991,361); and Claims 1-4, 6, 7, 10-12 and 29 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by Matsuoka (6,540,406).

It is respectfully submitted that these rejections should be withdrawn in view of the following remarks.

In order for a claim to be anticipated under 35 U.S.C. § 102, a single prior art reference must disclose each and every element of the claim in exactly the same way. See *Lindeman*

Machinenfabrik v. Am. Hoist and Derrick, 730 F.2d 1452, 1458 (Fed. Cir. 1984), and *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987).

Independent Claims 1 and 29, as amended, each recite both an axle and a sleeve each having portions with differing diameters. That is, neither element as claimed now has one continuous smooth surface. Indeed, the axle 1 now has a small diameter portion 1a and a large diameter portion 1b, and likewise, the sleeve 2 now has a small inner diameter portion 2a and a large inner diameter portion 2. Support for such amendments comes from the Specification, paragraphs [0035] through [0040], and the physical configuration is shown in Figures 16 and 19. Additionally, such limitations were originally claimed separately in dependent claims 2 and 5.

With regard to the cited prior art and the first added limitation of an axle having two portions with differing diameters, it is clear that the Horberg reference (U.S. Patent No. 2,953,417), Standing et. al. reference (4,173,376), the Ogata et. al. reference (5,000,589), the Ohtsuki et. al. reference (5, 718, 049), and the Beaman reference (5, 829, 891) do not teach or disclose an axle having two portions with differing diameters.

With regard to the cited prior art and the second added limitation of a sleeve having two portions with differing diameters, it is clear that the Horberg reference (U.S. Patent No. 2,953,417), Standing et. al. reference (4,173,376), the Miyatake et. al. reference (4,719,352), the Ogata et. al. reference (5,000,589), the Ohtsuki et. al. reference (5, 718, 049), the Beaman reference (5, 829, 891), and the Matsuoka reference (6,540,406) do not teach or disclose a sleeve having two portions with differing inner diameters.

With regard to the only remaining piece of cited prior art, that is, the Bhatt reference (5,991,361), and each of the two added limitations to independent claims 1 and 29, Bhatt does not teach or disclose a sleeve having two inner portions with differing diameters. Bhatt, on the

other hand, discloses that the first X-ray tube shaft 112 generally circumferentially surrounds the second X-Ray tube shaft 120. See the Bhatt reference, column 3, lines 46-48, and Figures 1 and 2. In other words, such inner circumferential surface is all of equal diameter. There is clearly no teaching or suggestion anywhere to be found in Bhatt of a sleeve with differing inner diameters.

Accordingly, it is respectfully submitted that the Examiner's rejections of claims 1-14, 29 and 30 has been overcome.

VI. Claim Rejections under 35 U.S.C. § 103(a).

The Examiner has made two rejections under 35 U.S.C. § 103 independently rejecting dependent claims 5 and 2-7. That is, Claim 5 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Matsuoka as applied to claims 1-4 above, and further in view of EP 786,604, and Claims 2-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horberg, Standing, Miyatake, Ogata et. al., and Beaman, individually, as applied to claim 1 above and further in view of EP 786,604.

With regard to the rejection of Claim 5 by the Examiner in combining the Matsuoka reference (6,540,406) with the EP 786,604 A2 reference, in accordance with MPEP § 804.03 Applicant is filing a Terminal Disclaimer under 37 C.F.R. § 1.130(b) to disqualify the commonly owned Matsuoka reference (6,540,406) as prior art. The current application and the Matsuoka reference (6,540,406) are both commonly owned by the assignee of record, or subject to an obligation of assignment to, Minebea Co., Ltd. For this purpose a formal Terminal Disclaimer in accordance with 37 C.F.R. § 1.321(c) is herewith attached. An authorization for payment by deposit account for the fee in the amount of \$130.00 for entry of this Terminal Disclaimer is contained below.

With regard to the rejection of Claims 2-7 by the Examiner in combining the Horberg, Standing, Miyatake, Ogata et. al., and Beaman references, individually, with the EP 786,604 A2 reference, Applicant wishes to bring to the Examiner's attention that the EP 786,604 A2 reference is a counterpart of and related to U.S. Patent No. 5,556,209 in that each of these two references descends from and claims priority to Japanese Patent Application No. 292126.

Applicant also wishes to bring to the attention of the Examiner that U.S. Patent No. 5,556,209 and its foreign counterpart EP 786,604 A2 list the same inventor, Rikuro Obara, and the same assignee, Minebea, as the present application. (Minebea Co., Ltd. and Minebea Kabushiki-Kaisha are one and the same company ("Kabushiki-Kaisha" is Japanese for "company incorporated")). Accordingly, in accordance with MPEP § 718 Applicant is filing a Terminal Disclaimer under 37 C.F.R. § 1.130(b) to disqualify the commonly owned EP 786,604 A2 reference as prior art. For this purpose a second formal Terminal Disclaimer in accordance with 37 C.F.R. § 1.321(c) is herewith attached. An authorization for payment by deposit account for the fee in the amount of \$130.00 for entry of this second Terminal Disclaimer is contained below.

Accordingly, upon entry of each of the attached Terminal Disclaimers submitted herewith, Applicant contends that the Examiner's rejections under 35 U.S.C. § 103(a) are moot and that the rejections of Claim 5 and 2-7 should be withdrawn.

VII. Conclusion.

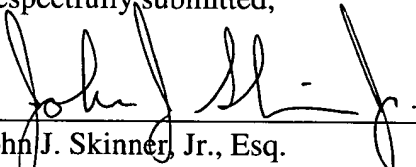
In light of the above amendments and remarks, it is therefore respectfully submitted that claims 1-14, 29 and 30 are allowable. All issues raised by the Examiner have been addressed, and therefore an early and favorable action on the merits is earnestly solicited.

The Examiner is urged to telephone Applicants' undersigned counsel at the number noted below if it will advance the prosecution of this application, or with any suggestion to resolve any condition that would impede allowance.

Fees totaling \$260.00 for entry of the two terminal disclaimers are believed to be due. As such, the Commissioner is hereby authorized to charge the \$260.00 and any additional fee, or credit any surplus, in connection with this Response to Deposit Account No. 50-0675, Order No. 051319-0060. In the event that any extension of time is required, Applicant petitions for that extension of time required to make this response timely.

Date: August 17, 2005

Respectfully submitted,



John J. Skinner, Jr., Esq.
Reg. No. 42,153

Schulte Roth & Zabel, LLP
919 Third Avenue
New York, NY 10022
Tel. (212) 756-2000